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Paper No. 8
RFC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Mattel, Inc.
v.
Todd Mount

Opposition No. 117,521
to application Serial No. 75/455,601
filed on March 24, 1998.

Jill M. Pietrini of Manatt, Phelps & Phillips, LLP for Mattel, Inc.

H. William Larson of Larson & Larson, P.A. for Todd Mount.

Before Cissel, Holtzman and Bottorff, Administrative Trademark Judges.

Opinion by Cissel, Administrative Trademark Judge:

On March 24, 1998, applicant filed the above-referenced application to register the mark "SLIME LIGHTS" on the Principal Register for "decorative lights," in Class 11. The stated basis for filing the application was applicant's assertion that he possessed a bona fide intention to use the mark in commerce in connection with these goods. At the Examining Attorney's request, applicant amended the identification-of-goods clause to read as follows: "electric

decorative lights," and disclaimed the exclusive right to use the word "LIGHTS" apart from the mark as shown.

Following publication in accordance with Section 12 of the Lanham Act, a timely Notice of Opposition was filed on February 16, 2000 by the Mattel, Inc., a corporation organized in existing under the laws of the state of Delaware. As grounds for opposition, opposer pleaded prior use and ownership of federal registrations for the mark "SLIME" in connection with freeflowing play gel[1] and collector cards[2]; prior use and ownership of applications to register the mark "SLIME" in connection with "t-shirts and caps"[3] and "computer services, namely, providing information through a global computer network in the field of toys, games, playthings, and collectible toys"[4]; prior use and ownership of a registration for the mark "SLIME-INATOR" in connection with "toy vehicles and accessories therefore, namely, play gel";[5] and that the mark applicant seeks to register, "SLIME LIGHTS," so resembles opposer's family of

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[1] Reg. No. 2,206,408, issued on the Principal Register on December 1, 1998, claiming first use and use in commerce on February 18, 1976.
[2] Reg. No. 2,097,841, issued on the Principal Register on September 16, 1997, claiming first use and use in commerce on February 18, 1976.
[3] Application S.N. 75/155,200.
[4] Application S.N. 75/157,921.
[5] Although opposer pleaded ownership of a registration for this mark and argued in its brief as if it had established this fact, no registration number was pleaded, and no registration for this mark for these goods was made of record by means of opposer's Notice of Reliance. Accordingly, opposer did not establish the registration of this mark as a basis for opposition.

"SLIME" marks that if applicant were to use the mark in connection with electric decorative lights, confusion would be likely. Applicant's answer to the Notice of Opposition denied the allegation that confusion would be likely.

A trial was conducted in accordance with the Trademark Rules of Practice, but apparently only opposer participated. On January 8, 2001, within its testimony period, opposer filed a Notice of Reliance, making of record its pleaded "SLIME" registrations, as well as a copy of its first set of requests for admission from applicant and declarations from opposer's attorneys attesting to the fact that these requests for admissions were served, but not answered, notwithstanding a follow-up letter which was sent to counsel for applicant reminding applicant of its obligation to respond. Applicant took no testimony, nor did applicant submit any evidence. Opposer filed a brief, but applicant did not. No oral hearing before the Board was requested.

Notwithstanding the general denial of opposer's claims in applicant's answer to the Notice of Opposition, by virtue of the fact that applicant was served with opposer's requests for admissions, but failed to respond to any of them, and the fact that opposer made applicant's failure of record in connection with its Notice of Reliance, opposer's requests for admission are deemed admitted. Fed. R. Civ. P. 36(a), Trademark Rule 2.120(j)(3)(i). See also: TBMP

Section 527.04. Accordingly, applicant has admitted that at the time it selected the mark it seeks to register, applicant was aware of opposer's use of its "SLIME" marks; that applicant's electric decorative lights are consumer goods, intended to be sold by retailers to the general public; that the intended consumers of applicant's products to be sold under the mark sought to be registered are not sophisticated; that opposer's products bearing opposer's pleaded marks are sold through the same channels of trade through which applicant intends to sell his goods under the mark he seeks to register; that opposer's goods sold under its pleaded registered marks are related to electric decorative lights; that opposer's pleaded marks are famous; that applicant intentionally selected the mark he seeks to register in order to trade on opposer's goodwill and fame; and that when applicant selected the mark he seeks to register, he was aware that consumers may believe that applicant's decorative lights bearing the mark "SLIME LIGHTS" are affiliated or connected with, or sponsored or endorsed by, opposer.

Presented with these admissions, we would be hard pressed not to agree with both applicant and opposer that confusion with opposer's marks would be likely if applicant were to use the mark he seeks to register in connection with the goods specified in the opposed application. Plainly,

the test for determining whether confusion is likely set forth by the predecessor to our primary reviewing court in In re E.I. duPont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973) has been met. Use of applicant's mark, which is similar to opposer's famous family of marks, on related consumer products moving through the same channels of trade to the same unsophisticated consumers with the intention of trading on opposer's goodwill and fame would certainly be likely to cause confusion.

DECISION: The opposition is sustained under Section 2(d) the Lanham Act, and registration to applicant is refused.